

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed November 19, 2004. Upon entry of the amendments in this response, claims 1 – 35 remain pending. In particular, Applicant amends claims 1 and 19 – 35. Reconsideration and allowance of the application and presently pending claims are respectfully requested. In addition, Applicant does not intend to make any admissions regarding any other statements in the Office Action that are not explicitly referenced in this response.

I. Objections to the Specification

The Office Action indicates that the specification is objected to because of various informalities. The specification has been corrected as shown above. The title of the invention has also been amended as shown above. In response, Applicant amends the specification and title to conform with the Office Action's request.

II. Claim Objections

The Office Action indicates that claims 1 and 20 – 35 are objected to because of various informalities. The claims have been amended as shown above. In response, Applicant amends claims 1 and 20 – 35 to conform with the Office Action's request.

III. Rejections Under 35 U.S.C. §102

A proper rejection of a claim under 35 U.S.C. §102 requires that a single prior art reference disclose each element of the claim. *See, e.g., W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983).

A. Claims 1, 3, 7, 8, 10 – 12, 18 – 20, 25, 26, 28, 29
and 35 are Patentable Over Ellis

1. Claim 1 is Patentable Over *Ellis*

The Office Action indicates that claim 1 stands rejected under 35 U.S.C. §102(b) as being anticipated by WO 99/60790 to Ellis (“*Ellis*”). More specifically, the Office Action recites that “[a]s to claim 1, Ellis discloses... providing said future program prior to its later broadcast time... in response to a user request” (OA p 3, item 5). In response, Applicant amends claim 1 to more fully distinguish the patentable features of claim 1 over *Ellis*. Claim 1, as amended recites:

A method for providing media services via an interactive media services client device coupled to a programmable media services server device, said method comprising:

providing a user with an interactive program guide (IPG) displaying a television program schedule, the television program schedule including a future television program, said future television program scheduled to be **publicly** broadcast at a later time;

receiving user input requesting said future television program; and

providing said user with said future television program prior to said later time.

However, *Ellis* recites:

If a video-on-demand program of interest is found, the viewer has several options. For example, the viewer may: 1) request a video clip of the program, if available... 2) request the program... or 3) request more information about that program... If a video-on-demand program is requested, the configuration and control screen may appear which requires viewer input (step 104). The viewer may fill-out and submit this form to order the requested program.

If the selected program has been set to start immediately, the program guide will provide the program immediately. However, if the selected program is ordered for a later time, the program guide may automatically start the program at the later time.

Furthermore, the program guide may be configured to present a reminder screen (not shown) sometime before the selected program is to be shown so that the viewer is reminded of the scheduled start-time. When this reminder is received, the viewer may be given the option to: 1) watch the program at the scheduled time, 2) watch the program immediately, 3) reschedule the program to another time... or 4) cancel the selected program. (*Ellis* p. 25, line 28 to p. 26, line 10).

Applicant asserts that as illustrated in *Ellis*, Video-On-Demand is not “scheduled to be *publicly* broadcast at a later time,” as recited in claim 1, as amended. Therefore, “providing a user with an interactive program guide (IPG) displaying a television program schedule, the television program schedule including a future television program, said future television program scheduled to be publicly broadcast at a later time; receiving user input requesting said future television program; and providing said user with said future television program prior to said later time” are limitations not taught in *Ellis*. For at least this reason, Applicants assert that claim 1 as amended, is patentable over *Ellis*.

2. Claim 19 is Patentable Over *Ellis*

The Office Action indicates that claim 19 stands rejected under 35 U.S.C. §102(b) as being anticipated by WO 99/60790 to *Ellis* (“*Ellis*”). Applicant respectfully traverses this rejection on the grounds that the *Ellis* reference does not disclose, teach, or suggest all of the claimed elements. More specifically, the Office Action recites that “[a]s to claim 19, *Ellis* discloses... providing said future program prior to its later broadcast time... in response to a user request” (OA p 3, item 5). In response, Applicant amends claim 19 to more fully distinguish the patentable features of claim 19 over *Ellis*. Claim 19, as amended recites:

A media services device for providing a user with a media presentation, said device comprising:

logic configured to provide said user with an interactive program guide (IPG) displaying a television program schedule, the television program schedule including identifying a future television program, said future television program scheduled to be publicly broadcast at a later time; and

logic configured to provide said user with said future television program prior to said later time in response to receiving user input requesting said future television program.

However, *Ellis* recites:

If a video-on-demand program of interest is found, the viewer has several options. For example, the viewer may: 1) request a video clip of the program, if available... 2) request the program... or 3) request more information about that program... If a video-on-demand program is requested, the configuration and control screen may appear which requires viewer input (step 104). The viewer may fill-out and submit this form to order the requested program.

If the selected program has been set to start immediately, the program guide will provide the program immediately. However, if the selected program is ordered for a later time, the program guide may automatically start the program at the later time.

Furthermore, the program guide may be configured to present a reminder screen (not shown) sometime before the selected program is to be shown so that the viewer is reminded of the scheduled start-time. When this reminder is received, the viewer may be given the option to: 1) watch the program at the scheduled time, 2) watch the program immediately, 3) reschedule the program to another time... or 4) cancel the selected program. (*Ellis* p. 25, line 28 to p. 26, line 10).

Applicant asserts that as illustrated in *Ellis*, Video-On-Demand is not “scheduled to be **publicly** broadcast at a later time” as recited in claim 19, as amended. Therefore, “logic configured to provide said user with an interactive program guide (IPG) displaying a television program schedule, the television program schedule including identifying a future

television program, said future television program scheduled to be publicly broadcast at a later time; and logic configured to provide said user with said future television program prior to said later time in response to receiving user input requesting said future television program” are limitations not taught in *Ellis*. For at least this reason, Applicants assert that claim 19, as amended is patentable over *Ellis*.

3. Claims 3, 7, 8, 10 – 12, 18, 20, 25, 26, 28, 29, and 35 are Patentable Over *Ellis*

In addition, dependent claims 3, 7, 8, 10 – 12, and 18 are believed to be allowable for at least the reason that these claims depend from allowable independent claim 1. Further, dependent claims 20, 25, 26, 28, 29, and 35 are believed to be allowable for at least the reason that they depend from allowable independent claim 19. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

V. Rejections Under 35 U.S.C. §103

In order for a claim to be properly rejected under 35 U.S.C. §103, the teachings of the prior art reference must suggest all features of the claimed invention to one of ordinary skill in the art. *See, e.g., In re Dow Chemical*, 837 F.2d 469, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988); *In re Keller*, 642 F.2d 413, 208 U.S.P.Q. 871, 881 (C.C.P.A. 1981). Further, “[t]he PTO has the burden under section 103 to establish a prima facie case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

A. Claims 2 and 22 are Patentable Over *Ellis* in View of *Kostreski*

The Office Action indicates that claims 2 and 22 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Ellis* in view of U.S. patent number 5,534,912 to *Kostreski* (“*Kostreski*”). Applicant respectfully traverses this rejection for at least the reason dependent claim 2 depends from allowable independent claim 1 and dependent claim 22 depends from allowable independent claim 19. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

B. Claims 4 and 21 are Patentable Over *Ellis*

The Office Action indicates that claims 4 and 21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Ellis*. Applicant respectfully traverses this rejection for at least the reason dependent claim 2 depends from allowable independent claim 1 and dependent claim 22 depends from allowable independent claim 19. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

C. Claims 5, 6, 23 and 24 are Patentable Over *Ellis* in View of *Matthews*

The Office Action indicates that claims 5, 6, 23 and 24 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Ellis* in view of U.S. patent number 5,815,145 to *Matthews*, III (“*Matthews*”). Applicant respectfully traverses this rejection for at least the reason dependent claim 2 depends from allowable independent claim 1 and dependent claim 22 depends from allowable independent claim 19. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

D. Claims 9, 15, 16, 17, 27, 32, 33 and 34 are Patentable Over *Ellis* in View of *Girard*

The Office Action indicates that claims 9, 15, 16, 17, 27, 32, 33 and 34 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Ellis* in view of U.S. patent number 5,751,282 to Girard, et al. ("*Girard*"). Applicant respectfully traverses this rejection for at least the reason dependent claim 2 depends from allowable independent claim 1 and dependent claim 22 depends from allowable independent claim 19. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

E. Claims 13, 14, 30 and 31 are Patentable Over *Ellis* in View of *Gordon*

The Office Action indicates that claims 13, 14, 30 and 31 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Ellis* in View of U.S. patent number 5,682,597 to Gordon, et al. ("*Gordon*"). Applicant respectfully traverses this rejection for at least the reason dependent claim 2 depends from allowable independent claim 1 and dependent claim 22 depends from allowable independent claim 19. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

Cited Art Made of Record

The cited art made of record has been considered, but is not believed to affect the patentability of the presently pending claims.

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 1 – 35 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



Jeffrey R. Kuester; Reg. No. 34,367

**THOMAS, KAYDEN,
HORSTEMEYER & RISLEY, L.L.P.**
Suite 1750
100 Galleria Parkway N.W.
Atlanta, Georgia 30339
(770) 933-9500